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REMARKS:

Claim Rejection – 35 USC § 103

The OA rejected claims 25-32, 34-43, and 45 as being unpatentable over Bier (US Patent Publication No. 20040261023) in view of Dooley (US Patent Publication No. 20020035611). The OA rejected claims 33, 44, and 46-63 as being unpatentable over Bier in view of Dooley, in further view of Feeley (US Patent Publication No. 20040068460). Applicant respectfully traverses this rejection.

MPEP 2143 Basic Requirements of a Prima Facie Case of Obviousness

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

I. IT WOULD NOT HAVE BEEN OBVIOUS TO COMBINE BIER AND DOOLEY

A. Bier is Nonanalogous Art

The Examiner did not respond in the OA to Applicant's argument that Bier is nonanalogous art, but instead changed the grounds for the rejection by asserting that Bier is reasonably pertinent to the particular problem with which the applicant was concerned. Thus, Applicant will rely on its arguments in its February 13, 2007 Reply that Bier is nonanalogous art, consider this point conceded, and move on to discuss why Bier is also not reasonably pertinent to the particular problem with which the applicant was concerned.

B. Bier is not reasonably pertinent to the particular problem with which the applicant was concerned.

The Examiner responded to Applicant's argument that Bier is nonanalogous art as follows:

To begin, in response to applicant's argument that Bier is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor, or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24

USPQ2d 1443 (Fed. Cir. 1992). In this case, Bier is definitely pertinent to the particular problem with which it was relied upon as a basis for rejection of the claim language, which is to primarily show the use of receiving access to a Web site code, wherein the Web site comprises the Web site code. (underlining added)

1. The Examiner, after correctly stating the test from *In re Oetiker*, applied a different incorrect test

The Examiner correctly states the requirements from *In re Oetiker* for combining prior art references as either in the field of the applicant's endeavor or "be reasonably pertinent to the particular problem with which the applicant was concerned." However, when the Examiner restated the *In re Oetiker* test in the OA on page 12, it incorrectly came out as "Bier is definitely pertinent to the particular problem with which it was relied upon as a basis for rejection of the claim language." Thus, the Examiner applied a totally different test than the one from *In re Oetiker*. Specifically, being "pertinent to the particular problem with which it was relied upon as a basis for rejection of the claim language" (Examiner's test) is not the same as being pertinent to the particular problem with which the applicant was concerned (*In re Oetiker's* test). Applicant respectfully submits that the Examiner has incorrectly stated and applied the *In re Oetiker* test.

When the correct test is used, a very different result than that found by the Examiner is obtained. The particular problem with which the applicant was concerned (the correct test from *In re Oetiker*) is increasing traffic flow to a Web site. This is supported by the Field of the Invention on page 1, Summary of the Invention starting on page 3, Abstract on page 19, and preambles of all the independent claims in the patent application as support for "increasing traffic flow to a Web site" as being the particular problem with which the applicant was concerned. Once the correct test is applied, it becomes readily apparent that Bier is not "reasonably pertinent" to increasing traffic flow to a Web site (no mention of this is found or cited within Bier) and thus cannot be used as a prior art reference against the application.

2. The *In re Oetiker* decision (cited by the Examiner) does not support the Examiner's position

The Examiner relied on *In re Oetiker* which states in pertinent part:

It has not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments. The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself. (citations omitted)

Thus, just as in *In re Oetiker* where it was not obvious to look to fasteners for garments in seeking to solve a problem of fastening a hose clamp, it would not have been obvious to look at “[a] system and method for automatic conversion of web pages to shared structured web pages” (first sentence in Abstract of Bier) in seeking to solve a problem of increasing traffic flow to a web site (present invention). These are very different problems that require very different solutions.

Stated another way, just as the court in *In re Oetiker* did not find being related to “fasteners” as sufficient for permitting a reference to be used, it is not sufficient by itself (assuming for the moment that this is even true) that Bier and the present invention are both related to receiving access to a Web site code as asserted by the Examiner.

In addition, if the *In re Oetiker* court had used the Examiner’s test, i.e. “Bier is definitely pertinent to the particular problem with which it was relied upon as a basis for rejection of the claim language,” the court would have come to a very different decision. This is supported by *In re Oetiker* where it states in pertinent part:

Oetiker's invention is an improvement in a “stepless, earless” metal clamp, a hose clamp that was generally described in an earlier '004 patent of Oetiker, but that differs in the presence of a feature that is described as a preassembly “hook”. This “hook” serves both to maintain the preassembly condition of the clamp and to be disengaged automatically when the clamp is tightened.

The cited references were Oetiker's earlier-granted '004 patent, combined with a certain Lauro '004 patent. Lauro describes a plastic hook and eye fastener for use in garments, in which “unitary tabs of sewing needle puncturable plastic material ... are affixable to clothing and the like by sewing”.

If the court had used the Examiner’s test and looked to see if Lauro ‘004, which apparently was used to disclose the “hook” limitation, was “pertinent to the particular problem” related to hooks (teaching used by the Examiner in that case), the court would have reasonably found Lauro ‘004 to be pertinent to problems related to hooks. Of course, this is not what the court actually did or found.

In actuality, the *In re Oetiker* court went on to conclude that Lauro '004 was improperly used as a reference by the Examiner. The Lauro court made this decision (even though Lauro '004 was reasonably pertinent to the element it was used to disclose ("hooks")) stating "[i]t has not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments." Being pertinent to the disclosed element (Examiner's test) is not enough, the reference must "be reasonably pertinent to the particular problem with which the applicant was concerned." Thus, the Bier reference simply does not meet the test articulated and applied by the case cited by the Examiner, *i.e.*, *In re Oetiker* because Bier is not reasonably pertinent to the particular problem with which the applicant was concerned, *i.e.*, increasing traffic flow to a website.

3. No motivation to make the combination because Dooley purports to accomplish all the stated reasons for the combination by itself.

The Examiner's stated motivation to combine the reference is found in the OA on page 3 and states:

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Dooley's teachings into the Bier system. A skilled artisan would have been motivated to combine as suggested by Dooley at [0010], in order to provide an information network on the Internet, wherein the information, products, and services of a website will be accessed in order to provide value to the website owner. As a result, obtaining high volume traffic at the least cost per visitor.

The section cited by the Examiner (Dooley at [0010]) is in the Background of the Invention section and Dooley purports to solve and accomplish all of these goals. Specifically, Dooley at [0011] in the first paragraph of the Summary of the Invention states:

Therefore, a need has arisen for a system and method for providing an informational network on the Internet that overcomes these and other drawbacks of the related art.

Thus, Dooley purports to overcome "these and other drawbacks of the related art" which the Examiner used as the motivation to combine. Dooley then continues to describe in detail an informational network that Dooley claims accomplishes the problems it outlined in the Background of the Invention (where the Examiner got the motivation to combine). As another example, Dooley at [0017] lines 26-30 states:

It is yet another technical advantage of the present invention to increase the potential of obtaining high volume Internet traffic without requiring conventional branding, advertising, or promotional methods to drive traffic into the network. (underlining added)

Thus, Dooley claims to be able to perform the motivational factors used by the Examiner all by itself. If Dooley claims to solve all of the motivational factors by itself, then there is no reason or motivation for Dooley to be combined with Bier as asserted by the Examiner.

4. No motivation to make the combination because the Examiner's stated motivational factors may be accomplished in many ways unrelated to Bier.

In addition, all of the motivational factors mentioned by the Examiner are very abstract and may be accomplished in many different ways that may be totally unrelated to Bier. None of the stated motivational factors even fairly suggest using the teachings of Bier in anything more than a superficial or tangential manner. The Examiner's stated motivation to combine is found in the OA on page 3 and states:

A skilled artisan would have been motivated to combine as suggested by Dooley at [0010], in order to provide an information network on the Internet, wherein the information, products, and services of a website will be accessed in order to provide value to the website owner. As a result, obtaining high volume traffic at the least cost per visitor.

These abstract benefits listed by the Examiner may be accomplished in many ways other than using Bier. Thus, there is no reason, motivation or suggestion to make the Examiner's proposed combination as the stated reasons are insufficiently to invoke or even fairly suggest to one of ordinary skill in the art at the time of the invention to use the teachings of Bier.

C. The Proposed Modifications to Bier would render Bier unsatisfactory for its Intended Purpose

The Examiner's response in the OA on page 12 to Applicant's argument that the proposed modifications to Bier would render Bier unsatisfactory for its intended purpose is as follows:

Further, in response to applicant's argument that the proposed modification from Dooley to Bier would render Bier unsatisfactory for its intended purpose is improper. The test is not whether the features of a secondary reference may be bodily incorporated into the structure of a primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871

(CCPA 1981). Therefore, the examiner strongly believes that the incorporation would provide an information network on the Internet, wherein the information, products, and services of a website will be accessed in order to provide value to the website owner. As a result, obtaining high volume traffic at the least cost per visitor.

As a preliminary matter, Applicant respectfully submits that the Examiner has mischaracterized Applicant's argument. Specifically, the Examiner stated above that "[t]he test is not whether the features of a secondary reference may be bodily incorporated into the structure of a primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references." Applicant made no such arguments and was very clear that Applicant was arguing that the proposed modification would render Bier unsatisfactory for its intended purpose. This argument is not only proper, but specifically allowed by MPEP 2143.01.

Next, the Examiner states "[r]ather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981)." While this is correct, the problem with the Examiner's argument is that in determining "what the combined teachings of the references would have suggested to those of ordinary skill in the art" it is entirely appropriate to consider whether the proposed modification would render the prior art unsatisfactory for its intended purpose. If the proposed modification would render the prior art invention unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)

One of the proposed modifications to Bier (described specifically for independent claim 25 and in roughly related manners for independent claims 36, 46, 55, and 56) is the limitation from Dooley of "a means for analyzing the Web site code, wherein the means for analyzing the Web site code comprises a means for checking for a known factor in the Web site code used by a plurality of search engines in ranking a plurality of Web sites for registration ([0056], lines 36-46, Dooley)." (OA, page 3) The result of such an analysis of Web site code would necessarily reflect whether the Web site code had a known factor used by search engines in ranking Web sites.

On the other hand, the primary reference, Bier, is used to disclose the limitation of "a means for causing the Web site code to be edited based on a result from the means for analyzing the Web site code ([0081], Bier)" (emphasis added) (OA, page 4). The problem is that if the

means for editing (from Bier) are “based on” the “means for checking for a known factor . . . used by search engines in ranking . . . Web sites” (from Dooley) (the combination proposed by the Examiner), Bier would not be able to automatically make group-writable Web pages ([0008], Bier), its intended purpose. Stated another way, there is no way Bier could automatically make group-writable Web pages if its method of modifying Web site code was based on an analysis looking for known factors used by search engines in ranking Web sites. Thus, the proposed modifications to Bier would render Bier unsatisfactory for its intended purpose.

D. The Proposed Modification Would Change Bier’s Principle Of Operation.

In addition, the proposed modification would change Bier’s principle of operation. (Please see MPEP 2143.01 VI) If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)

As shown above, not only would the proposed modification render Bier unsatisfactory for its intended purpose, it would also change Bier’s principle of operation. Specifically, Bier modifies group-writable Web pages and the last sentence in Bier’s Abstract generally states its principle of operation as “[t]he conversion process includes parsing the Web page into an intermediate structure, adding information to individual tokens about the structures in which the tokens play a part, and them [sic] generating the new page while making one or more final passes through the intermediate structure from beginning to end.” However, the Examiner’s proposed combination would force Bier to modify Web site code based on an analysis of looking for known factors used by search engines in ranking Web sites. Ignoring for the moment the fact that this proposed combination would not even work, the Examiner’s proposed modification would clearly change Bier’s principle of operation. Thus, the proposed combination is also improper as it would change Bier’s principle of operation.

II. BIER, DOOLEY, AND FEELEY DO NOT TEACH OR SUGGEST ALL THE CLAIM LIMITATIONS OF INDEPENDENT CLAIMS 25, 36, 46, 55, AND 56

Applicant respectfully submits that Bier, Dooley and Feeley do not teach or suggest all of the claimed limitations as more fully explained below. Thus, all pending claims are patentable over the cited prior art under § 103.

INDEPENDENT CLAIM 25

A. Bier does not disclose a program for increasing traffic flow to a Web site

The Examiner in the OA on page 13 did not give the recitation “a program for increasing traffic flow to a Web site” patentable weight because the recitation occurs in the preamble. Applicant agrees the portion of the preamble that states “for increasing traffic flow to a Web site” should not be given patentable weight. MPEP at 2111.02 II generally excludes purpose or use language from preambles as being used as limitations.

However, Applicant respectfully disagrees with respect to the portion of the preamble of claim 25 which states “[a] program.” MPEP at 2111.02 I states in relevant part “[a]ny terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation.” See, e.g., *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989). Since “[a] program” is terminology in the preamble that limits the structure of the claimed invention it must be treated as a claim limitation and given patentable weight. Yet, the Examiner did not do so.

Even the cite used by the Examiner in *In re Hirao* agrees with this structure vs. purpose dichotomy in the preamble by stating “[a] preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone.” Thus, the Examiner’s own cite gives support for giving patentable weight to the structure of “[a] program” from the preamble since it does not merely recite the purpose of a process or the intended use of a structure.

Applicant would also like to point out that while “[a] program” is stated in the preamble for independent claim 25, independent claims 36, 46, 55, and 56 repeatedly include the limitation “[a] program” **in the body of the claims**. The Examiner appears to have totally missed this fact and assumed that the limitation of “[a] program” was in all of the independent claim’s preambles. Thus, the Examiner’s preamble argument does not even apply to claims 36, 46, 55, and 56 (although the Examiner lumped these claims into the Examiner’s preamble argument).

B. Dooley does not disclose a program means for receiving a list of search engines

1. “A program” in the preamble is a structure (not a use or a function) and thus should have been given patentable weight.

The Examiner starts by arguing “a program” from the preamble should not be given patentable weight. Applicant respectfully disagrees as fully explained above. (Please see MPEP at 2111.02 I and II.) Applicant would like to repeat that the Examiner’s preamble argument should not have even been applied to claims 36, 46, 55, and 56 which include the limitation of “a program” within the body of the claims.

2. Even if the prior art shows “a program” and in a different context shows “a list of search engines,” this does not disclose a program means for receiving a list of search engines.

While the Examiner may have shown in the OA on page 14 that “programs” are known in the prior art and, in a different context, that “search engines” are known in the prior art, this does not disclose the limitation of a program means for receiving a list of one or more search engines. “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). The Examiner has not shown a teaching in the references of a program means for receiving a list of one or more search engines. Specifically, none of the “programs” cited by the Examiner in Bier or in Dooley receive a list of search engines (and none of the lists of “search engines” cited by the Examiner in Bier or in Dooley are received by a program). Showing that the individual words were known

separately in different contexts does not show that the claimed relationship of those words was also known.

3. The prior art teachings of a user accessing a search engine does not teach the claim limitations of a program means for receiving a list of search engines.

The Examiner in citing Dooley [0050] lines 8-11 in the OA on pages 14-15 states:

“The user may also access a conventional search engine or browser (e.g., google.com, yahoo.com, netscape.com, northerlight.com, etc.) and enter a search request”. The examiner interprets the accessing of a conventional search engine to correspond to the act of receiving. (underlining added)

There are two problems with the Examiner’s argument. First, the Examiner’s cite from Dooley clearly states it is a user that accesses the search engine. While the Examiner disputes whether claim 25 includes the limitation of a “program” because it is in the preamble, there is no doubt claims 36, 46, 55, and 56 include the limitation of “the program receiving a list” in the body of the claims. Thus, not only does Dooley not disclose the limitation of “the program receiving a list,” the cite provided by the Examiner in Dooley actually teaches away from this claim limitation by teaching a user (instead of a program) accesses a search engine.

Second, a user accessing a search engine does not correspond to a program receiving a list of one or more search engines. The Examiner has not made a prima facie showing that a user accessing a search engine fairly teaches or discloses a program receiving a list of one or more search engines. These actions (accessing vs. receiving) in their respective contexts are performed not only by different actors (user vs. program) but are performed in very different ways, using different means, producing different results and simply do not correspond with each other.

The plain meaning of words must be used, unless the specification dictates otherwise. One of ordinary skill in the art at the time of the invention would not think a user accessing a search engine corresponded to a program receiving a list of search engines. Thus, at least this limitation is not taught by the prior art.

4. The prior art teachings of registering websites with search engines does not disclose the claim limitations of a program receiving a list of search engines.

The Examiner in the OA on page 15 states:

A further example for this particular limitation can be found within Dooley at paragraph [0066], lines 5-15, wherein “The major groupings of advantageous features of the information network of the present invention include . . . registration of websites with search engines”; examiner interprets the registration with search engines to further disclose the above limitation.

Applicant respectfully submits that Dooley’s teaching of “registration of websites with search engines” does not correspond to a program receiving a list of search engines. In fact, these are entirely different steps in the currently claimed embodiments of independent claims 25, 36, 46, 55, and 56. Specifically, all pending independent claims include limitations for both of these functions as follows:

25. A program for increasing traffic flow to a Web site, comprising:

...

b) a means for receiving a list of one or more search engines to submit the Web site to for registration;

...

e) a means for submitting the Web site, with the edited Web site code, for registration to the one or more search engines on the list.

36. A process for increasing traffic flow to a Web site from one or more search engines, comprising the steps of:

...

b) the program receiving a list of one or more search engines to submit the Web site to for registration;

...

e) the program submitting the Web site for registration, having the modified Web site code, to the one or more search engines.

46. A process for increasing traffic flow to a Web site from a search engine, comprising the steps of:
- ...
- c) the program receiving a list of one or more search engines to submit the Web site to for registration;
- ...
- g) the program submitting the Web site for registration, having a modified Web site code, to the one or more search engines on the list.
55. A process for increasing traffic flow to a Web site from a plurality of search engines, comprising the steps of:
- ...
- c) the program receiving a list of search engines to submit the Web site to for registration;
- ...
- g) the program submitting the Web site for registration, having a modified Web site code, to the search engines on the list.
56. A process for increasing traffic flow to a Web site from one or more search engines, comprising the steps of:
- ...
- c) the program receiving a list of one or more search engines to submit the Web site to for registration;
- ...
- g) the program submitting the Web site for registration to the one or more search engines on the list; and

As can be seen from the above selected claim elements from independent claims 25, 36, 46, 55, and 56, a program or means of “receiving” a list of search engines is a different claim element from a program or means of “submitting” a Web site for registration. Thus, the Examiner has not shown that a program or means of receiving a list of search engines was known by merely

showing that part of a different step was known, i.e. where Dooley at [0066] states “registration of websites with search engines”.

C. Including software code into a website design (Dooley) is not the same as a means or a program for analyzing Web site code (Claims 25, 36, 46, 55, and 56).

The Examiner in the OA on page 15 in attempting to use Dooley to disclose a means or a program for analyzing Web site code states:

Examiner respectfully disagrees. As stated in the action above, Dooley disclose at paragraph [0056], lines 36-46, wherein “In another embodiment, enhanced placement may be attained by the inclusion of a variety of additional software code elements (e.g., Java applets, cookies, and other elements) within the website(s) design, which may be weighted favorably by search engines”. Examiner interprets the ‘attaining by the inclusion of a variety of additional software code elements’ to correspond to the analyzing of the Web site code and also, the examples given for the software code elements such as Java applets, cookies, and other elements within the websites design, which is weighted favorable by search engines, to correspond to the known factors used by search engines. (underlining added)

The words of a claim must be given their plain meaning unless the plain meaning is inconsistent with the specification. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (Please see MPEP 2111.01 I.) The plain meaning refers to the ordinary and customary meaning given to the term by those of ordinary skill in the art. (Please see MPEP 2111.01 III.) “[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313, 75 USPQ2d 1321, 1326 (Fed. Cir. 2005) (en banc).

Here, the claim term is a means or a program for “analyzing” the Web site code and the term must be given its ordinary and customary meaning that the term would have to a person of ordinary skill in the art at the time of the invention. The Examiner’s cite in Dooley teaches “[i]n another embodiment, enhanced placement may be attained by the inclusion of a variety of additional software code elements (e.g., Java applets, cookies, and other elements) within the website(s) design, which may be weighted favorably by search engines.” (underlining added) Applicant respectfully submits that using the plain meaning rule reveals that one of ordinary skill in the art at the time of the invention would not consider including software code elements into a

website design (Dooley) the same as a means or a program analyzing the Web site code (claims 25, 36, 46, 55, and 56). Put as straightforward as possible, including code into a website design is not the same as analyzing the code of a website.

Thus, while Dooley may teach including software code elements or design elements within the website design ([0056], Dooley) and Bier may teach detecting and parsing web page code ([0081], Bier), there is no teaching or suggestion in Dooley or Bier of a program analyzing the Web site code for a known factor used by search engines. To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). The plain meaning of including code does not correspond to analyzing code. Thus, Applicant respectfully submits that this cobbling together (incompletely) of Dooley and Bier is improper as it does not consider the plain meaning of the words in the claim in judging patentability as required by *In re Zletz*.

INDEPENDENT CLAIM 36

- A. Dooley does not teach or suggest the program receiving a list of one or more search engines**
 - 1. The Examiner mistakenly asserted the limitation “program” was in the preamble even though it is in the body of claim 36.**

The Examiner lumped claim 36 with the other claims in proclaiming in the OA on page 14 that:

Also, in response to the argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., 'a program means for') are not explicitly recited in the rejected claim(s). . . . In particular, while the preamble does state a program, the actual claim language merely states "a means for". (underlining added)

The limitation of a program is only in the preamble for claim 25. The limitation of a “program” receiving a list of search engines is included in the body of claims 36, 46, 55, and 56. Thus, the Examiner has misread and improperly examined claims 36, 46, 55, and 56.

2. **Even if the prior art shows “a program” and in a different context shows “a list of search engines,” this does not disclose “the program receiving a list of one or more search engines.”**

As fully discussed regarding claim 25, while the Examiner may have shown in the OA on page 14 that “programs” are known in the prior art and, in a different context, that “search engines” are known in the prior art, that does not disclose the limitation of a “program receiving a list of one or more search engines.” Claim 36 should be allowed at least for this reason.

3. **The prior art teachings of a user accessing a search engine does not teach the claim limitations of a program receiving a list of search engines.**

As fully discussed regarding claim 25, using the plain meaning rule, one of ordinary skill in the art at the time of the invention would not consider a user accessing a search engine to teach the claim limitation of a program receiving a list of search engines. Claim 36 should be allowed at least for this reason.

4. **The prior art teachings of registering websites with search engines does not disclose the claim limitations of a program receiving a list of search engines.**

As fully discussed regarding claim 25, using the plain meaning rule, one of ordinary skill in the art at the time of the invention would not consider teachings regarding registering websites with search engines to disclose the claim limitation of a program receiving a list of search engines. Claim 36 should be allowed at least for this reason.

- B. **Neither Dooley nor Bier teach a program facilitating a modification of the Web site code to increase traffic flow**

The OA on pages 16-17 alleges that: 1) Bier teaches “facilitating a modification of the Web site code”; and that 2) Dooley’s teaches “to the increase in traffic flow” and the “to the facilitation of a modification of the Web site code as a way of increasing traffic.” Even if all these statements are true, the combination of Bier and Dooley still does not add up to a program facilitating a modification of the Web site code to increase traffic flow to a Web site. This piecemeal method of using references to show pieces of the limitation in different contexts simply

does not teach the claimed relationships of the pieces within the limitation.

The Examiner has had to selectively take parts of Bier and parts of Dooley to, incompletely, recreate this single limitation. “Where prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself.” *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 5 U.S.P.Q.2d 1434 (C.A.F.C. 1988) (emphasis added). “That one can reconstruct and/or explain the theoretical mechanism by means of logic and sound scientific reasoning does not afford the basis for an obviousness conclusion unless that logic and reasoning also supplies sufficient impetus to have led one of ordinary skill in the art to combine the teachings of the references to make the claimed invention.” *Ex parte Levengood*, 28 U.S.P.Q. 2d 1300 (P.T.O.B.A&I. 1993) (emphasis added). Applicant respectfully submits that the fact that it takes two references to cobble together (incompletely) a single limitation is strong evidence that the invention is not made obvious by the references.

C. Neither Dooley nor Bier teach the program submitting the Web site for registration

The OA at page 6 states “the program submitting the Web site for registration, having the modified Web site code ([0192], Bier), to the one or more search engines ([0050], lines 12-18, Dooley).” The OA does not provide a cite in either Dooley or Bier for the first portion of the limitation, specifically “the program submitting the Web site for registration.” To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Since the cited references do not disclose a “program submitting the Web site for registration,” the rejection should be withdrawn and the claim allowed.

The Examiner argues in the OA on page 17 that:

Applicant argues, neither Bier nor Dooley teach “the program submitting the Web site for registration”.

Examiner respectfully disagrees. As stated in the action above, Dooley discloses at paragraph [0050], lines 12-18, wherein “The search engine may identify relevant websites that have been registered with or located by the particular search engine, and may return this search

results list to the user”. Examiner interprets the identifying of relevant websites that have been registered as demonstrating that the website at one point in time had to have been submitted for registration in order for the site to already be registered.”

While Dooley may disclose “websites that have been registered with . . . search engines,” it does not disclose the limitation of a program submitting a Web site for registration (and certainly not where that program also does all the other steps attributed to it in claim 36).

The Examiner continues on with:

To further support the above argued limitation, Dooley disclose at paragraph [0031], wherein “the selected domain names may be registered, purchased, and/or leased from the current owner”,

Here, the Examiner is confusing “registering domain names with a registrar” with “registering websites with a search engine”. These are totally separate processes and a process related to registering a domain name with a registrar (Dooley [0031]) simply does not correspond to a process of a program submitting a Web site for registration with a search engine (claim 36).

The Examiner continues on with:

and paragraph [0056], lines 27-29, wherein “enhanced placement may be affected by registration of website URLs with Internet search engines or brokers on their behalf”. Examiner interprets the above citations to correspond to the argued limitation and in particular since the websites are up for registration it is evident they have been submitted.

While Dooley may teach “registration of website URLs with Internet search engines”, it does not disclose the limitation of a program submitting a Web site for registration (and certainly not where that program also does all the other steps attributed to it in claim 36).

INDEPENDENT CLAIMS 46, 55, AND 56

A. Dooley does not teach the program receiving a list of one or more search engines to submit the Web site to for registration

The OA on page 9 states “the program receiving a list of one or more search engines to submit the Web site to for registration” is disclosed at ([0056], lines 27-46, Dooley). Applicant respectfully disagrees. While Dooley may disclose several well known search engines ([0050], Dooley) and state “[i]n one embodiment, enhanced placement may be affected by registration of website URLs with Internet search engines or brokers on their behalf”, there is no teaching or

suggestion in Dooley, Bier or Feeley of a program receiving a list of search engines to submit a Web site to for registration.

As fully discussed for claim 25, section B, sections 2-5, Dooley does not teach a program receiving a list of one or more search engines to submit the Web site to for registration as stated in the OA on pages 13-15.

B. Dooley does not teach a program analyzing the Web site code using the determined ranking methodology.

The OA on page 9 states “the program analyzing the Web site code using the determined ranking methodology ([0056], lines 36-46, Dooley).” Dooley ([0056], lines 36-46) states:

In another embodiment, enhanced placement may be attained by the inclusion of a variety of additional software code elements (e.g., Java applets, cookies, and other elements) within the website(s) design, which may be weighted favorably by search engines. In another embodiment, enhanced and/or optimized placement within search engine results may be affected by all or a subset of the website design element embodiments listed above (e.g., plurality of links, use of simple descriptive domain names, content with keywords, registration with search engines, embedded metatags, etc.). The plurality of these web design features may provide additional or synergistic traffic into and within the member websites of the information network.

Thus, while Dooley may teach including software code elements or design elements within the website design ([0056], Dooley) and Bier may teach detecting and parsing web page code ([0081], Bier), there is no teaching or suggestion in Dooley or Bier of a program analyzing the Web site code using the determined ranking methodology. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Thus, Applicant respectfully submits that using Dooley as a reference for this limitation is improper as Dooley does not teach or suggest all of the words in the claim as required by *In re Wilson*.

The OA on page 18 further states:

Applicant argues, Dooley does not teach “a program analyzing the Web site code using the determining ranking methodology”.

Examiner respectfully disagrees. To begin, the objective of the Dooley reference is essentially based on a ranking methodology, as discussed within paragraph [0016], wherein “According to another embodiment of the present invention, a method for enhancing a probability

of high placement of a webpage by a search engine is provided”.

Even if Dooley does provide “a method for enhancing a probability of high placement of a webpage by a search engine,” this does not teach the claim limitation of “a program analyzing the Web site code using the determined ranking methodology.”

The OA on page 18 continues:

Further, paragraph [0056], lines 1-6, disclose “a combination of elements or features of the website design may be utilized to enhance high level placement of the member websites or web pages within search engine results”. Examiner interprets the enhanced high-level placement to correspond to the determination of a ranking methodology.

Again, even if Dooley does disclose “a combination of elements or features of the website design may be utilized to enhance high level placement of the member websites or web pages within search engine results,” this still does not teach the claim limitation of “a program analyzing the Web site code using the determined ranking methodology.” Specifically, the Examiner’s cite from Dooley is referring to including elements into website design, there is nothing about a program analyzing the Web site code.

The Examiner’s stated interpretation of this cite from Dooley is that it “correspond[s] to the determination of a ranking methodology.” Even assuming the Examiner is correct, determination of a ranking methodology” still does not teach “a program analyzing the Web site code using the determined ranking methodology.” The Examiner has simply not shown all the parts of the claim limitation.

The OA on page 18 then states:

Also, paragraph [0056], lines 36-40, discloses “enhanced placement may be attained by the inclusion of a variety of software code elements within the websites design, which may be weighted favorably by search engines”. As such, examiner further interprets favorable weighting by the search engine as disclosing a determination of a ranking methodology.

Yet again, even if Dooley does disclose “enhanced placement may be attained by the inclusion of a variety of software code elements within the websites design, which may be weighted favorably by search engines” this still does not teach the claim limitation of “a program analyzing the Web site code using the determined ranking methodology.”

In summation, the Examiner’s cites and interpretations of those cites (even assuming for the moment that all of the Examiner’s interpretations are correct) never teach or make inherent “a program analyzing the Web site code using the determined ranking methodology.”

C. Bier does not teach a program facilitating a modification of the Web site code to increase an expected traffic flow to the Web site

The OA on page 9 states “the program facilitating a modification of the Web site code based on the analyzing the Web site code ([0081], Bier) to increase an expected traffic flow to the Web site from the search engine ([0027], Dooley).”

Bier, at the cited paragraph ([0081], Bier) discloses a “method for converting input web pages to Sparrow Web type web pages” and a method “where the web page coding is detected and revised.” Dooley, at the cited paragraph ([0027], Dooley), discloses methods, particularly through the use of hyperlinks, of increasing traffic flow from search engines.

However, neither Bier nor Dooley teach or suggest a program facilitating a modification of the Web site code to increase traffic flow to a Web site. The Examiner has had to selectively take parts of Bier and Dooley to recreate this single limitation. “Where prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself.” *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 5 U.S.P.Q.2d 1434 (C.A.F.C. 1988) (emphasis added). “That one can reconstruct and/or explain the theoretical mechanism by means of logic and sound scientific reasoning does not afford the basis for an obviousness conclusion unless that logic and reasoning also supplies sufficient impetus to have led one of ordinary skill in the art to combine the teachings of the references to make the claimed invention.” *Ex parte Levengood*, 28 U.S.P.Q. 2d 1300 (P.T.O.B.A&I. 1993) (emphasis added).

Applicant respectfully submits that the fact that it takes two references to cobble together (incompletely) a single limitation is strong evidence that the invention is not made obvious by the references.

D. Dooley does not teach the program submitting the Web site for registration

As fully argued regarding claim 36, section C above, Dooley does not disclose a program submitting a Web site for registration (and certainly not where that program also does all the

other steps attributed to it in claims 46, 55, and 56). Thus, claims 46, 55, and 56 (and their dependent claims) should be allowed at least for this reason.

DEPENDENT CLAIMS 26-35, 37-45, 47-54

If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Since independent claims 25, 36, 46, 55, and 56 are believed to be allowable, variously dependent claims 26-35, 37-45, 47-54 should also be allowed.

CONCLUSION

All claims currently present in this application are believed allowable over all of the art of record and prompt further examination of the application and its allowance are respectfully requested. Any questions or suggestions regarding the application should be directed to the undersigned attorneys for Applicant at the telephone number listed below or by email to the email address listed below.

Respectfully submitted,

The Go Daddy Group, Inc.

Date: 10/3/2007

/Stewart J. Womack/ Reg.# 45,230
Stewart J. Womack
Attorney for Applicant

The Go Daddy Group, Inc.
14455 N. Hayden Road, Suite 219
Scottsdale, AZ 85260
480.505.8832
SWomack@GoDaddy.com